

**REMARKS**

Claims 1-9, 12-20, 22 and 24 were at issue. Claims 1-9, 12-20, 22 and 24 were rejected. The Examiner made the following rejections / objections:

1. The Examiner objected to the Terminal Disclaimer received by the U.S.P.T.O. on August 5, 2002.
2. The Examiner rejected claims 1-9, 12-20, 22 & 24 under 35 U.S.C. §112 (second paragraph) as being indefinite for failing to point out and distinctly claim the subject matter with the Applicants regard as the invention.
3. Claims 1, 2, 5-9, 12, 13, 16-20 & 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Dahll (U.S. Pat. No. 5,195,757).
4. Claims 1-9, 22 & 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Zitting (U.S. Pat. No. 4,577,874).
5. Claims 1,2, 4-7, 9, 12, 13, 15-18 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Blackman *et al.* (U.S. Pat. No. 5,452,771).
6. Claims 11-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zitting.
7. Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,105,968.

Applicants believe the present amendments and the following remarks traverse the Examiner's rejection of the claims. These remarks are presented in the same order as they appear above.

**1 & 7.                   The Applicants File Another Terminal Disclaimer**

In order to further their business interests, and without acquiescing to the Examiner's arguments, Applicants file herewith a Terminal Disclaimer, pursuant to 37 C.F.R. 1.321(c), which disclaims the terminal portion of the entire patent to be granted, in the instant application, beyond the expiration date of U.S. patent 6,105,968.

**2.                       The Rejection Under 35 U.S.C. §112 (Second Paragraph) Is Moot**

In order to further their business interests, and without acquiescing to the Examiner's arguments (while expressly reserving the right to prosecute the claims as filed or claims similar thereto), the Applicants have canceled all claims reciting the limitation objected to by the Examiner (e.g. "circumferentially located textured features"). Applicants note the limitation of "a seal ring bonded to a mounting ring", recited in the claims introduced in the instant amendment, finds express support in the specification of the application as filed.<sup>1</sup> Applicants submit that all pending claims are compliant with 35 U.S.C. §112 (Second Paragraph) and respectfully submit the Examiner withdraws the rejection.

**3, 4, and 5.           The Claims Are Not Anticipated**

In order to further their business interests, and without acquiescing to the Examiner's arguments (while expressly reserving the right to prosecute the claims as filed or claims similar thereto), the Applicants have: i) canceled pending claims 1-9, 12-20, 22, and 24 and ii) have entered a new claim set corresponding to claims 24-39. The claims introduced by the present amendment present two independent claims (e.g. claim 24 and claim 32) which introduce the element of "a seal bonded to a mounting ring"<sup>2</sup> into the assembly claims which issued as claim 1 and claim 9 of U.S. patent 6,105,968<sup>3</sup> to Yeh *et al.*

---

<sup>1</sup> See, for example, page 5, lines 9-17 of the application as filed.

<sup>2</sup> The incorporation of this element, into claims previously issued in U.S. patent 6,105,968 to Yeh *et al.*, creates patentably distinct subject matter such that the pending claims should not be subject to a rejection under "Same Invention-Type Double Patenting" based on 35 U.S.C. § 101.

<sup>3</sup> The instant application claims priority to U.S. patent 6,105,968 to Yeh *et al.*. Applicants note, therefore, the '968 patent may not be held as prior art against the instant application.

Applicants respectfully submit that no single piece of art cited by the Examiner, in the Office Action mailed October 09, 2002, discloses each and every element of the selected embodiments of the invention as presently claimed. Given that a single reference must disclose each limitation of a claim, in order for that reference to anticipate the claim, the Applicants submit that none of the art in question is adequate to sustain a rejection under 35 U.S.C. § 102(b). See, *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). Applicants, therefore, respectfully request the pending rejections under 35 U.S.C. §102(b) be withdrawn.

**6. The Claims Are Not Obvious**

Once again, in order to further their business interests, and without acquiescing to the Examiner's arguments (while expressly reserving the right to prosecute the claims as filed or claims similar thereto), the Applicants have: i) canceled pending claims 1-9, 12-20, 22, and 24 and ii) have entered a new claim set corresponding to claims 24-39.

The Examiner rejected (now canceled) claims 11-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. patent 4,577,874 to Zitting. Applicants submit that Zitting, i) does not disclose each and every element recited in the pending independent claims and ii) fails to provide a teaching which renders obvious the claimed embodiments of the present invention. Specifically, Zitting is silent on a first surface wherein said first surface comprises a seal ring bonded to a mounting ring wherein said seal ring comprises an outer peripheral edge and textured features interior to said outer peripheral edge said textured features comprising protrusions extending outward from said first surface such that a substantially flat second surface is in motion relative to said first surface.

Applicants specifically note the contact surfaces 51 (see, Figs. 2 and 3 and col. 5, line 66) in Zittig are cylindrical and not substantially flat. In addition, as Applicants noted in their previous correspondence, both the apex 41 and apex portion 132 are defined by Zitting as *the contact surface* and not as *protrusions* extending outward from a contact surface. That is to say, Zitting is silent on textured features interior to an outer peripheral edge, wherein said textured features comprise protrusions extending outward from the first surface.

These above referenced diverging elements of the instant application, as compared to the '874 patent, represent conscious design choices by the Applicants that confer advantages

to the device as claimed. As one example, the Applicants note the arrangement of textured features interior to an outer peripheral of the contact surface of the seal produces localized high pressure points that create a barrier and, moreover, any dirt that does come in contact with the textured features breaks up.<sup>4</sup>

Applicants renew their previous argument that the Examiner fails to make a *prima facie* case of obviousness. In addition Applicants have, in the instant correspondence, highlighted how structural aspects unique to the claimed embodiments of the present invention address problems (e.g. the infiltration of dirt into a seal) associated with seals described in the prior art. Applicants respectfully request, therefore, the pending rejections under 35 U.S.C. §103(a) be withdrawn.

**7. The Applicants Submit Proposed Amendments To The Drawings**

The Examiner attached Form PTO-948 to the Office Action mailed October 09, 2002. However, neither the Examiner, or the Official Draftsperson, set out a specific objection to the pending Informal Drawings. The Applicants have amended, *sua sponte*, Figures 1a, 1b, 2a, 2b, 3, & 4 (see, attached at Tab 1) pursuant to the procedures set out in 37 CFR 1.85(b). Applicants respectfully request the Examiner evaluate these proposed amendments to the Figures and inform the Applicants if the same are suitable for Formal Drawings.

---

<sup>4</sup> See, Application as filed, page 2, lines 6-9.

**CONCLUSION**

The Applicants believe the arguments and amendments, set forth above, traverse the Examiner's rejections. The Applicants respectfully request that all pending rejection be withdrawn and that the application be passed to allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicant encourages the Examiner to call the undersigned collect at 617.252.3353.

Dated: April 9, 2003



Thomas W. Brown  
Registration No. 50,002

MEDLEN & CARROLL, LLP  
101 Howard Street, Suite 350  
San Francisco, California 94105  
617.252.3353.